02/8/06

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TRANSMITTAL OF APPEAL BRIEF

Docket No.
NY-THEOR 205.1 (10107436)

In re Application of: Charles Paclat

Application No.	Filing Date	Examiner	Group Art Unit
09/975,945-Conf. #9612	October 11, 2001	A. Khatri	2193

Invention: METHOD FOR DEVELOPING BUSINESS COMPONENTS

TO THE COMMISSIONER OF PATENTS:

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed: November 29, 2005 .

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[ ] A petition for extension of time is also enclosed.

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[x] The Director is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. 50-0624 .
This sheet is submitted in duplicate.

Dated: February 6, 2006

C. Andrew Im
Attorney Reg. No. : 40,657
FULBRIGHT & JAWORSKI L.L.P.
666 Fifth Avenue
New York, New York 10103
(212) 318-3359

Application No. (if known): 09/975,945 Attorney Docket No.: NY-THEOR 205-US1

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Fee Transmittal (1 page)
Appeal Brief
Appeal Brief Transmittal (1 page)
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PTO/SB/17 (01-06)
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Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL
For FY 2006

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT ($) 500.00

Complete if Known	
Application Number	09/975,945-Conf. #9612
Filing Date	October 11, 2001
First Named Inventor	Charles Paclat
Examiner Name	A. Khatri
Art Unit	2193
Attorney Docket No.	NY-THEOR 205-US1

METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____

☐ Deposit Account Deposit Account Number: 50-0624 Deposit Account Name: Fulbright & Jaworski L.L.P.

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, **except for the filing fee**

☒ Charge any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

	FILING FEES		SEARCH FEES		EXAMINATION FEES		
Application Type	**Fee ($)**	**Small Entity Fee ($)**	**Fee ($)**	**Small Entity Fee ($)**	**Fee ($)**	**Small Entity Fee ($)**	**Fees Paid ($)**
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	**Fee ($)**	**Small Entity Fee ($)**
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims	**Extra Claims**	**Fee ($)**	**Fee Paid ($)**
_____ - =	_____ x	_____ =	_____

HP = highest numer of total claims paid for, if greater than 20.

Indep. Claims	**Extra Claims**	**Fee ($)**	**Fee Paid ($)**
_____ - =	_____ x	_____ =	_____

HP = highest numer of independent claims paid for, if greater than 3.

Multiple Dependent Claims

Fee ($)	**Fee Paid ($)**

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is $250 ($125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

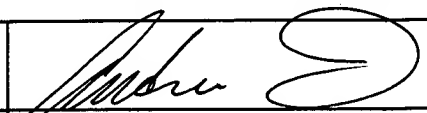
Total Sheets	**Extra Sheets**	**Number of each additional 50 or fraction thereof**	**Fee ($)**	**Fee Paid ($)**
_____ - 100 =	_____ /50	_____ (round **up** to a whole number) x	_____ =	_____

4. OTHER FEE(S) **Fees Paid ($)**

Non-English Specification, $130 fee (no small entity discount)

Other (e.g., late filing surcharge): 1402 Filing a brief in support of an appeal 500.00

SUBMITTED BY

Signature		Registration No. (Attorney/Agent)	40,657	Telephone	(212) 318-3359
Name (Print/Type)	C. Andrew Im			Date	February 6, 2006

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Name of Depositor: Fani Malikouzakis

Signature of Depositor Fani Malikouzakis

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant	:	Charles PACLAT
Serial No.	:	09/975,945
Filed	:	October 11, 2001
For	:	METHOD FOR DEVELOPING BUSINESS COMPONENT
Art Unit	:	2193
Examiner	:	Anil KHANTRI
Confirmation No.		9612

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

BRIEF ON APPEAL
(37 CFR §41.37)

Pursuant to 37 C.F.R. § 41.31, et seq. appellants hereby appeal from the final rejection of the above identified application.

The final rejection is dated August 30, 2005. Appeal was noted, on December 5, 2005.

Pursuant to 37 C.F.R. § 41.20(b)(2), the fee for filing this Brief is also submitted. The fee is believed to be $500.00. Should be check be missing or is insufficient, the Commissioner is authorization is make adjustment by way of Deposit Account No. 500624, if such is necessary.

The following items are submitted in accordance with 37 C.F.R. § 41.37(c)(1).

I REAL PARTY IN INTEREST

The real party interest is the assignee, BEA Systems, Inc.

II RELATED APPEALS AND INTERFERENCES

To the best knowledge of appellants, assignee, and the undersigned, there are no other prior or pending appeals, interferences, or judicial proceedings which may be related to, directly affect, or have a bearing on the Board's decision in this appeal.

III STATUS OF CLAIMS

Claims 1-18 were filed with the original application.

Original claims 1-18 are pending, all have been finally rejected, and all are appealed from.

IV STATUS OF AMENDMENTS

No amendments have been offered after the final rejection of August 30, 2005.

V SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter relates to a process for developing an Enterprise JavaBean (EJB) component by analyzing a business domain to generate functional requirements that models the business domain. The functional requirements are transformed into an EJB component model, preferably using a UML drawing tool. The resulting EJB component is then built from the EJB component model that encompass the business functionality of the business domain. The present process enables the user/developer to research business problems or domain (i.e., business project) and transforms them into EJB components. *See e.g.;* Figs. 1-7, page 4, line 18 to page 26, line 14.

VI GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

All claims have been rejected under 35 U.S.C. § 102(e) as being allegedly unpatentable over Fontana (U.S. Patent No. 6,167,564 issued to Fontana et al.). This may be seen at page 2 of the final Office Action.

This rejection is presented for review.

VII ARGUMENT

Claims 1-18 have been rejected under 35 U.S.C. §102(e) as being anticipated by Fontana. A rejection based on 35 U.S.C. §102 requires that the cited reference disclose each and every element covered by the claim. *Electro Medical Systems S.A. v. Cooper Life Sciences Inc.*, 32 U.S.P.Q.2d 1017, 1019 (Fed. Cir. 1994); *Lewmar Marine Inc. v. Barient Inc.*, 3 U.S.P.Q.2d 1766, 1767-68 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988); *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2D 1051, 1053 (Fed. Cir.), *cert. denied* , 484 U.S. 827 (1987). The Federal Circuit has mandated that 35 U.S.C. 102 requires no less than "complete anticipation ... [a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 772 F.2d 1542, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); *See also*, *Electro Medical Systems*, 32 U.S.P.Q. 2d at 1019; *Verdegaal Bros.*, 814 F.2d at 631.

A. Fontana Does Not Teach or Suggest Any of The Claimed Steps

The Examiner has failed to establish a case that Fontana is an anticipatory reference under 35 U.S.C. §102(e) because Fontana does not teach or suggest all the claim limitations of independent claim 1. In fact, appellant respectfully submit that Fontana does not teach or suggest any of the claim steps of independent method claim 1.

Fontana relates to a system for tracing "the influence of an action of one tool on other tools" (col. 3, lines 42-43; see also col. 11, line 31 to col. 12, line 32). This enables the system to integrate various existing software tools into "a coherent development framework in lieu of developing new tools" (col. 3, lines 37-40; see also col. 3, lines 1-17).

Contrary to the Examiner's assertion, Fontana does not teach or suggest "a method for developing an Enterprise JavaBean (EJB) component," as called for in all of the claims of the present invention. Appellant respectfully submits that the Examiner cannot use hindsight gleaned from the present invention to reconstruct or modify the prior art reference to render claims unpatentable. In fact, after a good-faith review of Fontana, appellant's representative could not find any passage in Fontana where it teaches a method for developing an EJB component as required in all of the claims of the present invention. In amendment filed on July 25, 2005, appellant requested that the Examiner to cite passage(s) in Fontana where it teaches a

method for developing EJB components. In response, the Examiner cited col. 10, lines 10-21 in Fontana and "noted that cited reference fairly suggests that EJB components were incorporated in business process application in heterogeneous environment" (Final Office Action, page 3, lines 2-3). Contrary to the Examiner's assertion, appellant respectfully submits that the present invention does not claim a method of incorporating EJB components, rather the present invention is directed to a method of developing EJB components. Morevoer, the Examiner cites only a portion of the paragraph and if the paragraph is read in its entirety (column 10, lines 6-22), Fontana clearly states that the environment is collected to build an application, such as vertical applications 100, custom applications 101 or legacy applications 102, and connecting protocols 104 (e.g., Enterprise Java Beans 106) are used to exchange messages between the vertical applications 100, custom applications and legacy applications 102. Therefore, appellant respectfully submits that cited passage does not support the Examiner's strained position that Fontana teaches or suggests a method for developing an EJB component as required in all of the claims of the present invention.

It is respectfully submitted that Fontana does not teach or suggest any of the claimed steps of claim 1 as noted herein. Accordingly, it is unclear to appellant how Fontana anticipates or renders obvious) the present invention as alleged by the Examiner.

1. Fontana Does Not Teach or Suggest The Step of Analyzing

Contrary to the Examiner's assertion, Fontana does not teach or suggest the step of "analyzing a business domain to determine functional requirements of said business domain," as required in claim 1. In fact, col. 7, lines 26-47 in Fontana, now cited by the Examiner merely describes that "A business domain is defined as an entity in an organization that accomplishes specific tasks for proper working of the organization as a whole. Examples of business domains are sales department, human resource department, or the information technology department." Previously, the Examiner cited Fig. 7 and col. 10, lines 6-22 in Fontana for allegedly teaching the step of analyzing (Office Action dated May 23, 2005, page 3). Whereas, the present invention defines business domain as business problems or projects (see page 3, lines 14-15; Abstract). It is appreciated that one of ordinary skill in the art would not equate "business entity" with "business project." The Examiner cannot reconstruct the prior art reference such that it contradicts the clear teaching of the reference. Therefore, since Fontana fails to teach or suggest

the step of analyzing as required in claim 1 (and included in dependent claims 2-18), it follows that, contrary to the Examiner's assertion, Fontana does not anticipate or render obvious claim 1, or any of dependent claims 2-18.

2. Fontana Does Not Teach or Suggest The Step of Transforming

Contrary to the Examiner's assertion, Fontana does not teach or suggest the step of "transforming said functional requirements into an EJB component model," required in claim 1. In fact, Fig. 5 and col. 8, lines 52-67 in Fontana, cited by the Examiner, merely describes "the interrelationships of the modules making up the development framework." Column 9, lines 6-23 in Fontana, now cited by the Examiner, merely describes that various modules are coupled to the repository." Previously, the Examiner cited col. 3, lines 24-30 in Fontana for allegedly teaching the step of transforming (Office Action dated May 23, 2005, page 3). It is respectfully submitted that the cited passages in Fontana do not even remotely support the Examiner's position. It is well established that the Examiner cannot use hindsight gleaned from the present invention to modify or reconstruct the prior art reference to render claims unpatentable. Therefore, since Fontana fails to teach or suggest the step of transforming as required in claim 1 (and included in dependent claims 2-18), it follows that, contrary to the Examiner's assertion, Fontana does not anticipate or render obvious claim 1, or any of dependent claims 2-18.

3. Fontana Does Not Teach or Suggest The Step of Building

Contrary to the Examiner's assertion, Fontana does not teach or suggest the step of "building an EJB component in accordance with said EJB component model that encompass the business functionality of said business domain," as required in claim 1. In fact, Fig. 8, col. 10, lines 60-67 and col. 11, lines 1-5 in Fontana et al., cited by the Examiner, merely illustrates and describes various screen that will appear if user clicks on certain button, e.g., the build screen will appear if the user clicks on the Reconstruct button 126. Previously, the Examiner cited col. 12, lines 28-32 in Fontana for allegedly teaching the step of building (Office Action dated May 23, 2005, page 3). It is respectfully submitted that Fontana et al. is merely describing their system for tracing "the influence of an action of one tool on other tools." (see col. 3, lines 42-43) and Fontana et al. does not teach or suggest the claimed step of "building an EJB component in accordance with said EJB component model that encompass the business functionality of said

business domain," as called for in claim 1. It is well established that the Examiner cannot use hindsight gleaned from the present invention to modify or reconstruct the prior art reference to render claims unpatentable. Therefore, since Fontana fails to teach or suggest the step of building as required in claim 1 (and included in dependent claims 2-18), it follows that, contrary to the Examiner's assertion, Fontana does not anticipate or render obvious claim 1, or any of dependent claims 2-18.

4. Fontana Does Not Teach or Suggest Additional Elements Taught by Dependent Claims

Contrary to the Examiner's assertion, Fontana does not teach or suggest the following additional elements taught by dependent claims 2, 3, 5-8, and 10-18:

Claim 2: Fontana et al. does not teach or suggest providing a parallel development process.

Claim 3: Fontana et al. does not teach or suggest extensible and configurable EJB components.

Claim 5: Fontana et al. does not teach or suggest EJB component model which encapsulates the data and process model of the said business domain.

Claim 6: Fontana et al. does not teach or suggest generating a list of inputs wherein each input identifies a resource relating to the business domain.

Claim 7: Fontana et al. does not teach or suggest generating eFunction matrix from a list of inputs.

Claim 8: Fontana et al. does not teach or suggest transforming the functional requirements using a unified modeling language (UML) tool to generate the EJB component model.

Claim 10: Fontana et al. does not teach or suggest building the EJB component from at least one of the following class stereotypes: Belonging, Session, Entity, Configurable Entity, Business Policy and Workflow.

Claim 11: Fontana et al. does not teach or suggest mapping eXtensible Markup Language (XML) to the EJB component model.

Claim 12: Fontana et al. does not teach or suggest dividing the business domain into one or more sub-domains, determining functional requirements for each of thed sub-domains;

and transforming each of the functional requirements for the sub-domains into the EJB component model.

Claim 13: Fontana et al. does not teach or suggest generating relational mappings and deployment descriptors.

Claim 14: Fontana et al. does not teach or suggest generating end-user documentation, developing unit tests to test the EJB component, and generating a reference implementation of the EJB component.

Claim 15: Fontana et al. does not teach or suggest verifying the end-user documentation to the EJB component.

Claim 16: Fontana et al. does not teach or suggest packaging the EJB component for deployment with container managed persistence.

Claim 17: Fontana et al. does not teach or suggest a Smart component having at least one of following Smart feature: SmartKey, SmartHandle and SmartValue.

Claim 18: Fontana et al. does not teach or suggest an eBusiness Smart component.

VIII CLAIM APPENDIX

A clean copy of appealed claims 1-18 is appended herein.

IX EVIDENTIARY APPENDIX

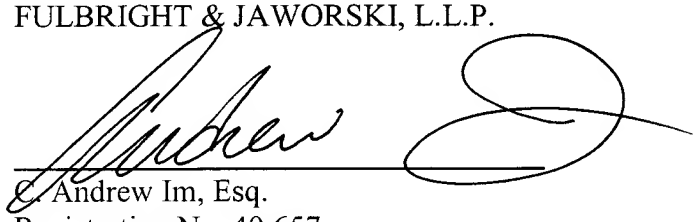
None.

X CONCLUSION

It is respectfully submitted, in light of above, all pending claims 1-18 are not anticipated nor obvious over Fontana because Fontana does not teach or suggest all of the claim limitations of independent claim 1. Therefore, appellants request that the Board reverse the pending grounds for rejection.

Respectfully submitted,

FULBRIGHT & JAWORSKI, L.L.P.



C. Andrew Im, Esq.
Registration No. 40,657

666 Fifth Avenue
New York, NY 10103
(212) 318-3000
(212) 318-3400 (fax)

Enclosures: **Check for Appeal Brief**
Clean Copy of Appealed Claims

CLAIMS APPENDIX
(37 C.F.R. § 41.37(c)(viii)

LISTING OF CLAIMS ON APPEAL

1. (Original) A method for developing an Enterprise JavaBean (EJB) component, comprising the steps of:

(a) analyzing a business domain to determine functional requirements of said business domain;

(b) transforming said functional requirements into an EJB component model; and

(c) building an EJB component in accordance with said EJB component model that encompass the business functionality of said business domain.

2. (Original) The method of claim 1, further comprising the steps of:

modifying said functional requirements by a user; and

repeating the steps (b) and (c) to provide a parallel development process.

3. (Original) The method of claim 1, wherein said EJB components are extensible and configurable.

4. (Original) The method of claim 1, wherein said functional requirements include data and process model of said business domain.

5. (Original) The method of claim 4, wherein said EJB component model encapsulates the data and process model of the said business domain.

6. (Original) The method of claim 1, wherein the step of analyzing includes the step of generating a list of inputs, each input identifying a resource that relate to said business domain.

7. (Original) The method of claim 6, further comprising the step of generating eFunction matrix from said list of inputs.

8. (Original) The method of claim 1, wherein the step of transforming transforms said functional requirements using an unified modeling language (UML) tool to generate said EJB component model.

9. (Original) The method of claim 8, wherein said EJB component model includes a plurality of EJB classes.

10. (Original) The method of claim 9, wherein the step of building builds said EJB component from at least one of the following class stereotypes: Belonging, Session, Entity, Configurable Entity, Business Policy and Workflow.

11. (Original) The method of claim 1, wherein the step of transforming includes the step of mapping eXtensible Markup Language (XML) to said EJB component model.

12. (Original) The method of claim 1, wherein the step of analyzing includes the step of dividing said business domain into one or more sub-domains and determining functional requirements for each of said sub-domains; and wherein the step of transforming transforms each of said functional requirements for said sub-domains into said EJB component model.

13. (Original) The method of claim 1, wherein the step of building includes the step of generating relational mappings and deployment descriptors.

14. (Original) The method of claim 1, wherein the step of building includes the steps of:

generating end-user documentation;

developing unit tests to test said EJB component; and

generating a reference implementation of said EJB component.

15. (Original) The method of claim 14, further comprising the step of verifying said end-user documentation to said EJB component.

16. (Original) The method of claim 14, further comprising the step of packaging said EJB component for deployment with container managed persistence.

17. (Original) The method of claim 1, wherein said EJB component is a Smart component having at least one of following Smart feature: SmartKey, SmartHandle and SmartValue.

18. (Original) The method of claim 16, wherein said Smart component is an eBusiness Smart component.

EVIDENTIARY APPENDIX
(37 C.F.R. § 41.37(C)(IX)

None.